

REMARKS

In the Office Action mailed May 11, 2004, the Examiner rejected claims 1, 3, 6, 8, 9 and 13. By way of the foregoing, applicant have canceled claims 2, 4, 5, 7, 10-12 and 14-21 and have added new claims 22-38. The foregoing is taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Election/Restriction

Claims 2, 4, 5, 7, 10-12 and 14-21 were withdrawn from consideration and are canceled by this amendment. Applicants cancel these claims to expedite prosecution. Applicants reiterate their traversal of the election/restriction requirement. The examiner in the present application has withdrawn all claims having a sealant material. In response to such withdrawal, Applicants state that there is no requirement in the presently pending claims that no sealant material be included in the attachment system. Thus, coverage of the claims of the present application can include attachment systems with sealant materials unless otherwise specifically specified. Applicants assume that the examiner has no objections to this analysis and the examiner is asked to put any objections on record if Applicants assumption is incorrect.

II. Claim Rejection – 35 USC 112

The Office Action rejected claim 3 under 35 USC 112 suggesting that the language of claim 3 is not clear because there, “are no exposed surfaces, which can to be [sic] primed or painted. Also figures fail to show the adhesive material to be primed or painted.” In response, Applicants submit a revised Fig. 4 showing a primer layer 100 and a paint layer 102 to assist in clearing any confusion. Applicants ask that the Examiner of the present application approve the revised drawing. In turn, Applicants will have the drawing formalized, as revised, and will add reference numerals 100 and 102 to the specification of the present application.

III. Claim Rejections – 35 USC 103

The Office Action rejected claims 1, 3, 6, 8-9 and 13 under 35 USC 103 as being unpatentable over Graber et al. (6,679,540) and in view of ordinary skill in the art. Applicants traverse these rejections on the ground that the Office Action fails to establish a prima facie case of obviousness against the aforementioned claims.

The MPEP 2143.03 reads, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claims 1, 6, 8-9 and 13

In rejecting claims 1, 3, 6, 8-9 and 13, the Office Action admits, at page 4, that Graber et al., “does not disclose the structural adhesive material having a tensile strength of at least 12 MPa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one the an automotive e-coat and an automotive painting operation.” The office then goes on, however, to make the conclusory statement that all of the subject matter not disclosed by Graber et al. would have been obvious, “since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Applicants contend that the Office Action has not shown the elements of the rejected claim and that the aforementioned conclusory statement does not excuse the the requirement that, “...all the claim limitations must be taught or suggested by the prior art.” *Ibid*. Moreover, absolutely no motivation is provided for combining the aforementioned elements (i.e., the elements not shown by Graber et al.) with the Graber et al. reference to arrive at the subject matter of the rejected claims. As such, the Office Action does not establish a prima facie case of obviousness against claims 1, 3, 6, 8-9 and 13, and the rejection of those claims should be withdrawn.

Claim 3

In addition to the above, the Office Action has completely failed to suggest the obviousness of the subject matter of claim 3. In particular, Applicants see no mention of a primer or paint layer or a class A or class B finish in the 35 USC 103 rejection. As such, the Office Action has failed to make any case of obviousness against claim 3 of the present application. Moreover, Applicants suggest that the 35 USC 112 rejection of claims does not relieve the examiner of the duty to make the obviousness rejection since even if the claims were indefinite¹, as stated in MPEP 2173.06, “The fact that terms may be indefinite does not make the claim obvious over the prior art.”

¹ It should be noted that Applicants believe that claim 3 of the present invention is definite.

Furthermore, Applicant points out that it would likely be improper to present a final rejection of claims 1, 3, 6, 8-9 and 13 on a grounds alternative to that already presented since applicants have not amended those claims in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

Additionally, any prior art rejection of claim 3 would likely have to be on alternative grounds since the Office Action made no prior art rejection of claim 3.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there

is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

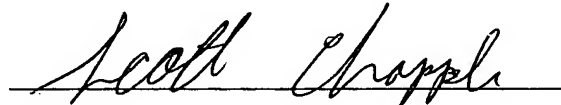
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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